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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|------------------------------|------------------------|
| 10/616,055 | 07/09/2003 | Amarpreet S. Sawhney | 3516.10US02 | 9525 |
| 62274 7590 05/24/2007 DARDI & ASSOCIATES, PLLC 220 S. 6TH ST. SUITE 2000, U.S. BANK PLAZA MINNEAPOLIS, MN 55402 | | | EXAMINER WEBMAN, EDWARD J | |
| | | | ART UNIT 1616 | PAPER NUMBER |
| | | | MAIL DATE 05/24/2007 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/616,055 | Applicant(s) SAWHNEY, AMARPREET S. | |
| | Examiner Edward J. Webman | Art Unit 1616 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-69 is/are pending in the application.
- 4a) Of the above claim(s) 9, 10, 32, 33 and 58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 11-31, 34-37, 59-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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After consideration of applicant's request for a pre-appeal conference filed 4/11/07, a consensus was reached to reopen prosecution on new grounds of rejection.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-8, 11-15, 20-28, 34-38, 41-50, 52-54, 59-60, 64-69 are rejected under 35 U.S.C. 102(e) as being anticipated by Hubbell et al (US 5,843,743).

Hubbell et al '743 teach gels comprising polymerized macromers used as supports for contact of biological materials with the body (title, abstract). PEG diacrylate is specified (column 5 line 66). Albumin is disclosed (column 6 line 49). Crosslinking is taught (column 5 line 12). Inorganic drugs are specified (column 8 line 21). Active peptides are disclosed (column 8 line 20). Cylinders and spheres are specified (column 13 line 56); microspheres are disclosed (column 9 line 61). Drying and reswelling are disclosed (column 26 lines 24-25).

As to the claimed properties of hydration and shape to occlude a space upon hydration, such must be inherently possessed by the obvious composition because it is the same as that claimed. As to the claimed creation of a lumen with a catheter and

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subsequent filling of the lumen with the swelled gel, such is merely an intended use. Applicants argue that the claimed percent volumetric expansion is not disclosed and that there is no showing that the claimed properties necessarily flow from teachings. However, such properties necessarily flow because the gel as claimed is identical to that of Hubbell et al '743.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 11-31, 34-57, 59-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hubbell et al (US 5,843,743) in view of Cole et al (US 4,948,575)

The description of Hubbell et al '743 in the 102 rejection *supra* is incorporated herein; the reference does not teach bubbles of carbon dioxide.

Cole et al teach the addition of an acid and carbonate salt as two separate components to generate carbon dioxide and thereby form a gel foam (title, abstract, Column 3 lines 49-56, column 3 line 68-column 4 line 4, column 4 lines 32-40). Prolonging the healing process of a wound is disclosed (column 2 lines 58-62).

It would have been obvious to one of ordinary skill to add an acid and carbonate salt as to separate components to the composition Hubbell et al '743 to achieve the

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beneficial effect of a foaming gel which prolongs the healing process of a wound. As to the claimed radio-opaque agent and dispersion of a hydrophobic agent, the addition of barium sulfate as a diagnostic agent would be an obvious expedient.

The inherency argument in the 102 rejection above is incorporated herein (See MPEP 2112 for inherency arguments in 103 rejections.)

Applicant also argues that one of ordinary skill would not consider Cole et al because the resultant hydrogel "could malfunction". However, applicant's choice of "could" in his argument indicates that even applicant recognizes that the teaching in Cole et al regarding swelling is merely cautionary.

No claims allowed.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward J. Webman whose telephone number is 571-272-0633. The examiner can normally be reached on M-F from 8 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. Richter, can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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